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Total Number of Pages in This Submission

20

Application Number	09/872,859
Filing Date	June 1, 2001
First Named Inventor	Coyle B. Marl
Art Unit	2157
Examiner Name	Hussein A. El Chanti
Attorney Docket Number	25587-031-006

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Postcard; authorization to charge Deposit Account No. 50-1847.
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Firm Name	Manatt Phelps & Phillips		
Signature	<i>Thomas George</i>		
Printed name	Thomas George		
Date	February 21, 2006	Reg. No.	45,740

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being sent via Express Mail No. EV 511900499US to the USPTO or deposited with the United States Postal Service to: Board of Patent Appeals and Interference, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Signature	<i>Leslie Hoffmann</i>		
Typed or printed name	Leslie Hoffmann	Date	February 21, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL for FY 2006

FEB 21 2006

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$500.00)

Complete If Known

Application Number	09/872,859
Filing Date	June 1, 2001
First Named Inventor	Coyle B. Marl
Examiner Name	Hussein A. El Chanti
Art Unit	2157
Attorney Docket No.	25587-031-006

METHOD OF PAYMENT (check all that apply)

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1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Small Entity Fee (\$)	Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Total Claims	Extra Claims	Fee (\$)
- 20 or HP = _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20		
Indep. Claims	Extra Claims	Fee (\$)
- 3 or HP = _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3		

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 = _____	/50 = _____	(round up to a whole number) x _____	= _____	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Fee for filing Appeal Brief 500.00

SUBMITTED BY

Signature <i>Thomas George</i>	Registration No. 45,740 (Attorney/Agent)	Telephone 650-812-1300
Name (Print/Type) Thomas George	Date 2/21/2006	

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



APPELLANTS : Coyle B. MARL, et al.
APPLICATION NO. : 09/872,859
FILED : June 1, 2001
FOR : METHOD AND SYSTEM FOR DETERMINING
INFORMATION TO ACCESS AN ELECTRONIC
MAIL ACCOUNT
ATTY. DOCKET NO. : 25587-031-006
GROUP ART UNIT : 2157
EXAMINER : Hussein A. EL CHANTI

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

APPEAL BRIEF

Dear Sir:

This brief is in furtherance of the Notice of Appeal filed in this case on December 21,
2005.

CERTIFICATE OF EXPRESS MAILING (37 C.F. R. § 1.10)

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1. REAL PARTY IN INTEREST

The real party in interest in this matter is Visto Corporation.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings known to Appellants, the undersigned attorney for Appellants, or the Assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF THE CLAIMS

Claims 2-11, 21-26, 28-29, and 31 are pending in this application.

Claims 2-11, 21-26, 28-29, and 31 were rejected.

No claims were allowed.

Claims 1, 12-20, 27, 30, and 32-35 were cancelled.

Claims 2-11, 21-26, 28-29, and 31 are being appealed.

4. STATUS OF AMENDMENTS

The Appellants did not make any amendments in the Response to the Final Rejection.

5. SUMMARY OF THE INVENTION

Independent claim 2 is directed to a method of determining information for accessing an electronic mail account according to an electronic mail protocol. According to one embodiment of the present invention, the method includes: receiving an address for delivering electronic mail to an electronic mail account (301); receiving a password for accessing the electronic mail account (301); extracting, from the address, a user name and an electronic mail account domain for the electronic mail account (305); and determining whether the electronic mail account domain, user name, and password can be used to access the electronic mail account according to the electronic mail protocol (307, 311, 315, 321, 325). The step of determining whether the electronic mail account domain, user name, and password can be used to access the electronic mail account according to the electronic mail protocol includes determining if the electronic mail account domain is included in a list of closed domains that do not include server computers

employing the electronic mail protocol (307). (*See, e.g.*, Specification, pg. 8, ln. 20 to pg. 16, ln. 13; FIGS. 3A, 3B, and 4).

Independent claim 21 is directed to a method of determining information for accessing an electronic mail account according to an electronic mail protocol. According to one embodiment of the present invention, the method includes: receiving an address for delivering electronic mail to an electronic mail account (301); receiving a password for accessing the electronic mail account (301); extracting, from the address, a user name and an electronic mail account domain for the electronic mail account (305); and determining whether the electronic mail account domain, user name, and password can be used to access the electronic mail account according to the electronic mail protocol (307, 311, 315, 321, 325). The step of determining whether the electronic mail account domain, user name, and password can be used to access the electronic mail account according to the electronic mail protocol includes the following: concatenating a server name prefix with the electronic mail account domain to form a default name for a server computer (319); and attempting to access the electronic mail account according to the electronic mail protocol by using the default name, the user name, and the password (321). (*See, e.g.*, Specification, pg. 8, ln. 20 to pg. 16, ln. 13; FIGS. 3A, 3B, and 4).

Independent claim 28 is directed to a device for determining information needed to access an electronic mail account according to an electronic mail protocol. According to one embodiment of the present invention, the device includes: an address decomposer (209) for decomposing an address for accessing an electronic mail account into a user name for the electronic mail account and a domain for the electronic mail account; a server mapper (211) for comparing the domain with a list of domains stored in a database; and a real time query unit (217) for attempting to access the electronic mail account according to the electronic mail account using the user name and the domain extracted from the address. The server mapper (211) is configured to compare the domain with a list of closed domains that do not include server computers employing the electronic mail protocol. (*See, e.g.*, Specification, pg. 6, ln. 21 to pg. 8, ln. 17; FIG. 2).

Independent claim 31 is directed to a device for determining information needed to access an electronic mail account according to an electronic mail protocol. According to one embodiment of the present invention, the device includes: an address decomposer (209) for decomposing an address for accessing an electronic mail account into a user name for the

electronic mail account and a domain for the electronic mail account; a server mapper (211) for comparing the domain with a list of domains stored in a database; a real time query unit (217) for attempting to access the electronic mail account according to the electronic mail account using the user name and the domain extracted from the address; and a host name generator (215) for concatenating a server name prefix with the electronic mail account domain to form a default name for a server computer. (*See, e.g.,* Specification, pg. 6, ln. 21 to pg. 8, ln. 17; FIG. 2).

6. **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Whether the rejection of claims 2-3, 21, 28-29, and 31 under 35 U.S.C. § 102(b) as being anticipated by WO 00/225443 to Hong ("*Hong*") is proper.

Whether the rejection of claims 4-11 and 22-26 under 35 U.S.C. § 103(a) as being obvious over *Hong* in view of "Official Notice" is proper.

7. **ARGUMENT**

A. **Claims 2-3, 21, 28-29, and 31 are not anticipated under 35 U.S.C. §102(b) by *Hong*.**

The issue is whether the rejection of claims 2-3, 21, 28-29, and 31 under 35 U.S.C. §102(b) as being anticipated by *Hong* is proper.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

i. **Claims 2-3, and 28-29**

With respect to claim 2, *Hong* does not disclose *inter alia* "determining if the electronic mail account domain is included in a list of closed domains that do not include server computers employing the electronic mail protocol" recited in claim 2. More specifically, *Hong* discloses a three phase search (described in greater detail below) to identify the user's e-mail server and retrieve the user's e-mail; however, none of these phases discloses "determining if the electronic

mail account domain is included in a list of closed domains that do not include server computers employing the electronic mail protocol” as recited in claim 2.

In a first stage of the first phase, the “remote access mail client 1” interrogates the “access database 2” to determine whether the user has a “user record indicating the user’s server and, if not, whether the database contains a domain record that corresponds to the presumed domain name of the user’s server.” (*Hong* at pg. 8, lns. 17-20). In a second stage of the first phase, the “remote access mail client assumes that the domain name is the user’s server and checks the domain name for the user’s mail.” (*Hong* at pg. 9, lns. 5-8). If it turns out that the domain name is not the user’s server, then the “remote access mail client 1 sends out a DNS inquiry to check for the MX [Mail eXchange] record.” (*Hong* at pg. 9, lns. 10-11). Each response received from the “DNS database 3” is checked to see if the “ports associated with the POP3/IMAP4 protocols, is/are open or closed. The user’s identi[t]y and log-in password is [sic] sent to any response having one of these ports open to [try to] retrieve the user’s mail” (*Hong* at pg. 9, lns. 16-19).

If the first phase fails to identify the user’s server, then the “remote access mail client 1” initiates a second phase. In the first stage of the second phase, the “remote access mail client 1” obtains the IP address from the MX record and checks the open or closed status of the ports 110 and 143 of the host IP addresses 2 to 254. (*Hong* at pg. 9, lns. 22-27). All the IP addresses whose port 110 and/or port 143 are open are subsequently checked to determine whether it corresponds to the user’s server. (*Hong* at pg. 9, lns. 27-29). If the user’s server is not found, then in a second stage of the second phase, the “entire list of names CANME and/or HOST is requested for the presumed domain name by zone transfer from the DNS database.” (*Hong* at pg. 10, lns. 3-4). The host names on the list are checked to determine whether their port 110 and port 143 are open, and the host names having open port status are checked to determine whether they correspond to the user’s server. (*Hong* at pg. 9, lns. 4-7).

If the second phase fails to identify the user’s server, then a third and final phase “retrieves from the WHOIS server the IP address block, INETNUM, NETNUMBER OR NETBLOCK, which has been allocated to the domain organization or company by the Networked Information Centre (NIC) and scans the ports 110 and 143 of the addresses in the block.” (*Hong* at pg. 10, lns. 11-14). All IP addresses having open ports are checked to determine whether they correspond to the user’s server. (*Hong* at pg. 10, lns. 14-16).

In the Final Office Action mailed July 28, 2005 (“Final Office Action”) and the Advisory Action mailed November 22, 2005 (“Advisory Action”), the Examiner asserts that *Hong* discloses the “determining” element at: (1) page 2, 4th paragraph (the Advisory Action specifically cites lines 25 to 28 of page 2); (2) page 6; and (3) page 10, 3rd paragraph. As discussed in greater detail below, these portions of *Hong* do not disclose the “determining” element.

With respect to page 2, 4th paragraph, the Advisory Action refers specifically to the portion of this paragraph that states: “listing the responses received from the DNS database; checking the responses in turn to determine whether a predetermined port or ports associated with the predetermined protocol or protocols is or are open or closed”. In the Advisory Action, the Examiner asserts that the “responses are used to determine a list of closed and open ports and therefore *Hong* teaches a list of closed domains.” However, nowhere in *Hong* is it stated that a list of domains is ever created where all the servers in any of the domains do not employ the e-mail protocol (e.g., have closed ports). The “responses” referred to by the Examiner relate to “e-mail servers” rather than “domains” and thus no list of “domains” (closed or otherwise) can be created from the “responses” relating to “e-mail servers”. Evidence that the “responses” relate to “e-mail servers” is provided at, e.g., page 9, lns. 11-16 which associates the “response” to the “user’s POP3/IMAP4 server” (page 9 elaborates on the second stage of the first phase which is introduced in page 2, 4th paragraph). Thus, this portion of *Hong* does not disclose “determining if the electronic mail account domain is included in a list of closed domains that do not include server computers employing the electronic mail protocol” as recited in claim 2.

Page 6 of *Hong* describes some of the items shown in Figure 1 such as the “access database 2”, the “DNS database 3”, the “WHOIS server 4”, and the “POP3/IMAP4 search engine 5”. The “access database 2” contains “user records” and “domain records”, the “DNS database 3” contains domain names and their corresponding IP addresses, and the “WHOIS server 4” contains IP address blocks allocated to domains, organizations, and companies. (*Hong* at pg. 6, lns. 22-25; and pg 8, lns. 18-20). However, none of these items contain a “list of closed domains that do not include server computers employing the electronic mail protocol”. Thus, this portion of *Hong* does not disclose “determining if the electronic mail account domain is included in a list of closed domains that do not include server computers employing the electronic mail protocol” as recited in claim 2.

Finally, *Hong* at page 10, 3rd paragraph states:

The entering of a record of the user's server in the access database 2 when and if the server is located, means that the system would not have to go through the same procedure again for a user with the same presumed domain name, since the user's server would be identified in the first stage of the first phase and access would be almost instantaneous.

This portion of *Hong* clearly does not disclose the "determining" element because this portion is merely explaining that if the user's e-mail server is found, then this information is recorded in the "access database 2". Thus, the "access database 2" contains e-mail servers that support a certain type of protocol. (See, e.g., *Hong* at FIGURE 2). This portion of *Hong* certainly does not disclose a "list of closed domains that do not include server computers employing the electronic mail protocol."

As discussed above, *Hong* describes obtaining DNS responses, IP addresses or host names associated with a domain name, and checking the corresponding servers for open mail ports. (*Hong* at p. 2, ¶ 4 – p. 3, ¶ 3). Those locations are then checked for a user's mail and, based on this query, "a record of any successful response is written into the access database 2." (*Hong* at p. 9, ¶ 3; see also, e.g., p. 9, ¶ 4 and p. 10, ¶¶ 1-2: "host names having open port status are written into the access database 2"; "a record of any successful host being written into the access database 2"). Accordingly, *Hong* merely teaches scanning ports 110 and 143 of servers to see if they are open, and then storing a list of names having open ports in access database 2. At no point does this involve using a list of closed domains as recited in the context of the present claims.

For at least these reasons, the Appellants assert that claim 2 is patentable over *Hong* and thus respectfully request reconsideration and allowance of claim 2. Claim 3 depends from claim 2. Accordingly, it is patentable over *Hong* at least for the reasons set forth above with respect to claim 2.

Similarly, claim 28 recites comparing "the domain with a list of closed domains that do not include server computers employing the electronic mail protocol." For at least the reasons provided earlier with respect to claim 2, the Appellants respectfully request allowance of claim 28. Claim 29 depends from claim 28. Accordingly, claim 29 is also patentable over *Hong*.

ii. Claims 21 and 31

With respect to claims 21 and 31, *Hong* does not disclose *inter alia* "concatenating a

server name prefix with the electronic mail account domain to form a default name for a server computer” recited in both claims 21 and 31. In the Final Office Action and the Advisory Action, the Examiner fails to address the “concatenating” element recited in claims 21 and 31 and does not cite to any portion of *Hong* that discloses this element. The Examiner seems to concede that *Hong* does not disclose the “concatenating” element recited in claims 21 and 31 because the Examiner when rejecting claim 22 (this claim depends from claim 21 and lists specific types of “server name prefixes”) under 35 U.S.C. § 103 conceded that *Hong* does not teach concatenating the specific *server name prefixes* listed in claim 22 but took “Official Notice” that using them is well known to one skilled in the art. (See, e.g., Final Office Action at pg. 5). The combining of *Hong* with the knowledge of one skilled in the art is improper under a 35 U.S.C. § 102 rejection. See, e.g., *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 1577 (Fed. Cir. 1991)(“If it is necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground is not § 102 anticipation, but § 103 obviousness.”).

Because the Examiner has not cited to any portion of *Hong* that discloses the “concatenating” element and seems to concede this inadequacy, the Appellants assert that *Hong* does not anticipate claims 21 and 31. Thus, the Appellants respectfully request reconsideration and allowance of claims 21 and 31.

B. Claims 4-11 and 22-26 are nonobvious over *Hong* in view of “Official Notice”.

The issue is whether the rejection of claims 4-11 and 22-26 under 35 U.S.C. § 103(a) as being obvious over *Hong* in view of “Official Notice” is proper.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

i. Claims 4-5

Claims 4-5 depend from claim 2. For the reasons provided earlier with respect to claim 2, the Appellants assert that *Hong* in view of the “Official Notice” taken by the Examiner does not disclose or suggest *inter alia* “determining if the electronic mail account domain is included in a list of closed domains that do not include server computers employing the electronic mail protocol.”

In addition, the Appellants assert that *Hong* in view of the “Official Notice” taken by the Examiner does not disclose or suggest *inter alia* “if only one computer server employing the electronic mail protocol is associated with the electronic mail account domain and the electronic mail account cannot be accessed through the one computer server, then prompting a user to resubmit the user name and password for the electronic mail account, and attempting to access the electronic mail account at the one computer server according to the electronic mail protocol by using the resubmitted user name and password” present in claims 4-5. On page 4 of the Final Office Action, the Examiner concedes that *Hong* fails to disclose the resubmission of the user name and password and the reattempt to access the e-mail account if only one computer server employing the e-mail protocol is associated with the e-mail account domain. The Examiner uses “Official Notice” to try to cure this deficiency. In order to properly understand the basis for the “Official Notice” and if appropriate, challenge it, the Appellants respectfully request that the Examiner cite a reference as documentary evidence in support of the “Official Notice” or provide an affidavit as required by M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2). *See, e.g., In re Ahlert*, 424 F.2d 1088, 1091 (C.C.P.A. 1970)(“Allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.”). The Appellants assert that it is not well known to one of ordinary skill in the art, in the context of finding the user’s e-mail account, to resubmit the user name and password and reattempt to access the e-mail account if only one computer server employing the e-mail protocol is associated with the e-mail account domain.

As shown above, because the “determining” element is neither disclosed nor suggested by the cited prior art, and the Examiner has not provided any evidence showing that the elements of claims 4-5 are well known, the Appellants assert that the Examiner has not established a *prima facie* case of obviousness and thus claims 4-5 are patentable over the prior art.

ii. Claims 6-11

Claims 6-11 depend from claim 2. For the reasons provided earlier with respect to claim 2, the Appellants assert that *Hong* in view of the “Official Notice” taken by the Examiner does not disclose or suggest *inter alia* “determining if the electronic mail account domain is included in a list of closed domains that do not include server computers employing the electronic mail protocol.”

In addition, the Appellants assert that *Hong* in view of the “Official Notice” taken by the Examiner does not disclose or suggest “concatenating a server name prefix with the electronic mail account domain to form a default name for a server computer; and attempting to access the electronic mail account according to the electronic mail protocol by using the default name, the user name and the password” present in claims 6-11. On page 5 of the Final Office Action, the Examiner seems to concede that *Hong* fails to disclose a “server name prefix” (e.g., “mail.”, “pop.”, or “pop3.”). The Examiner uses “Official Notice” to attempt to cure this deficiency. However, the Appellants assert that it is not known to one of ordinary skill in the art, in the context of finding the user’s e-mail account, to concatenate a server name prefix with the e-mail account domain to form a default server name and use this default name to access the user’s e-mail account. In the Response to the First Office Action mailed October 5, 2005 and in the Response to the Final Office Action, the Appellants repeatedly requested that the Examiner provide an affidavit in support of “Official Notice” of this element. However, the Examiner has never provided such an affidavit even though he is required to do so when requested by the Appellant. *See, e.g.*, M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

Because the “determining” element is neither disclosed nor suggested by the cited prior art, and the Examiner has not provided any evidence showing that the elements of claims 6-11 are well known even though such evidence was repeatedly requested, the Appellants assert that the Examiner has not established a *prima facie* case of obviousness and thus claims 6-11 are patentable over the prior art.

iii. Claims 22-23

The Appellants assert that *Hong* in view of the “Official Notice” taken by the Examiner does not disclose or suggest “concatenating a server name prefix with the electronic mail account domain to form a default name for a server computer; and attempting to access the electronic mail account according to the electronic mail protocol by using the default name, the user name

and the password” present in claims 22-23. On page 5 of the Final Office Action, the Examiner seems to concede that *Hong* fails to disclose a “server name prefix” (e.g., “mail.”, “pop.”, or “pop3.”). The Examiner uses “Official Notice” to attempt to cure this deficiency. However, the Appellants assert that it is not known to one of ordinary skill in the art, in the context of finding the user’s e-mail account, to concatenate a server name prefix with the e-mail account domain to form a default server name and use this default name to access the user’s e-mail account. In the Response to the First Office Action mailed October 5, 2005 and in the Response to the Final Office Action, the Appellants repeatedly requested that the Examiner provide an affidavit in support of “Official Notice” of this element. However, the Examiner has never provided such an affidavit even though he is required to do so when requested by the Appellant. *See, e.g.*, M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2). Because the above element is not well known to one skilled in the art, and the Examiner has not provided any evidence showing that it is well known even though such evidence was repeatedly requested, the Appellants assert that the Examiner has not established a *prima facie* case of obviousness and thus claims 22-23 are patentable over the prior art.

iv. Claims 24-26

Claims 24-26 depend from claim 2. For at least the reasons provided earlier with respect to claim 2, the Appellants assert that the proposed combination of *Hong* in view of the “Official Notice” taken by the Examiner does not disclose or suggest *inter alia* “determining if the electronic mail account domain is included in a list of closed domains that do not include server computers employing the electronic mail protocol.” The Examiner has never provided an affidavit showing that the elements recited in claims 24-26 are “common knowledge in the art.” In order to properly understand the basis for the Official Notice and challenge it if appropriate, the Appellants respectfully request that the Examiner cite a reference as documentary evidence in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2). Because the “determining” element is neither disclosed nor suggested by the proposed combination and the Examiner has not provided any evidence showing that the elements of claims 24-26 are well known, the Appellants assert that the Examiner has not established a *prima facie* case of obviousness and thus claims 24-26 are patentable over the prior art.

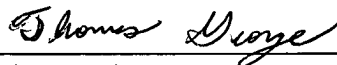
CONCLUSION

In summary, it has been demonstrated that the rejection of claims 2-11, 21-26, 28-29, and 31 under 35 U.S.C. §§ 102, 103 is improper. Accordingly, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the Examiner's rejection of these claims.

The Office is hereby authorized to charge any additional fees that may be necessary for consideration of this paper to Manatt, Phelps & Phillips Deposit Account No. **50-1847**.

Respectfully submitted,

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CLAIMS APPENDIX

1. (Cancelled)
2. (Previously presented) A method of determining information for accessing an electronic mail account according to an electronic mail protocol, comprising:
 - receiving an address for delivering electronic mail to an electronic mail account;
 - receiving a password for accessing the electronic mail account;
 - extracting, from the address, a user name and an electronic mail account domain for the electronic mail account; and
 - determining whether the electronic mail account domain, user name and password can be used to access the electronic mail account according to the electronic mail protocol, wherein the step of determining whether the electronic mail account domain, user name and password can be used to access the electronic mail account according to the electronic mail protocol includes determining if the electronic mail account domain is included in a list of closed domains that do not include server computers employing the electronic mail protocol.
3. (Original) The method recited in claim 2, wherein, if the electronic mail account domain is not included in the list of closed domains, further including:
 - accessing a list of known domains, such that at least one server computer known to employ the electronic mail protocol is associated with each of the known domains;
 - mapping the electronic mail account domain against the list of known domains; and
 - if the electronic mail account domain is included in the list of known domains, attempting to access the electronic mail account at one or more of the server computers associated with the electronic mail account domain using the user name and address.
4. (Original) The method recited in claim 3, wherein, if only one computer server employing the electronic mail protocol is associated with the electronic mail account domain and the electronic mail account cannot be accessed through the one computer server, then prompting a user to resubmit the user name and password for the electronic mail account, and attempting to

access the electronic mail account at the one computer server according to the electronic mail protocol by using the resubmitted user name and password.

5. (Original) The method recited in claim 4, wherein the user is prompted to resubmit the user name by resubmitting the address for delivering electronic mail to the electronic mail account.

6. (Original) The method recited in claim 4, wherein, if the electronic mail account cannot be accessed at the one computer server according to the electronic mail protocol by using the resubmitted user name and password, further including:

concatenating a server name prefix with the electronic mail account domain to form a default name for a server computer; and

attempting to access the electronic mail account according to the electronic mail protocol by using the default name, the user name and the password.

7. (Original) The method recited in claim 6, wherein the server name prefix is selected from the group consisting of: "mail.", "pop.", and "pop3."

8. (Original) The method recited in claim 6, wherein, if the electronic mail account cannot be accessed according to the electronic mail protocol by using the default server name, the user name and the password, further including the step of prompting a user to provide a server name for accessing the electronic mail account.

9. (Original) The method recited in claim 5, wherein, if the electronic mail account domain is not included in the list of known domains, further including

concatenating a server name prefix with the electronic mail account domain to form a default name for a server computer; and

attempting to access the electronic mail account according to the electronic mail protocol by using the default name, the user name and the password.

10. (Original) The method recited in claim 9, wherein the server name prefix is selected from the group consisting of: "mail.", "pop.", and "pop3."

11. (Original) The method recited in claim 9, wherein, if the electronic mail account cannot be accessed according to the electronic mail protocol by using the default server name, the user name and the password, further including the step of prompting a user to provide a server name for accessing the electronic mail account.

12-20. (Cancelled)

21. (Previously presented) A method of determining information for accessing an electronic mail account according to an electronic mail protocol, comprising:

- receiving an address for delivering electronic mail to an electronic mail account;
- receiving a password for accessing the electronic mail account;
- extracting, from the address, a user name and an electronic mail account domain for the electronic mail account; and
- determining whether the electronic mail account domain, user name and password can be used to access the electronic mail account according to the electronic mail protocol, wherein the step of determining whether the electronic mail account domain, user name and password can be used to access the electronic mail account according to the electronic mail protocol includes:
 - concatenating a server name prefix with the electronic mail account domain to form a default name for a server computer; and
 - attempting to access the electronic mail account according to the electronic mail protocol by using the default name, the user name and the password.

22. (Original) The method recited in claim 21, wherein the server name prefix is selected from the group consisting of: "mail.", "pop.", and "pop3."

23. (Original) The method recited in claim 21, wherein, if the electronic mail account cannot be accessed using the default server name, the user name and the address, further including prompting a user to provide a server name for accessing the electronic mail account.

24. (Previously presented) The method recited in claim 2, wherein the electronic mail protocol is selected from the group consisting of: the post office protocol, the Internet message access protocol, the Microsoft Exchange electronic mail protocol, and the Lotus Notes electronic mail protocol.

25. (Previously presented) The method recited in claim 2, wherein the address and password are received from a user of the electronic mail account.

26. (Previously presented) The method recited in claim 2, wherein the address and password are received from an electronic mail messaging software application.

27. (Cancelled)

28. (Previously presented) A device for determining information needed to access an electronic mail account according to an electronic mail protocol, comprising:

an address decomposer for decomposing an address for accessing an electronic mail account into a user name for the electronic mail account and a domain for the electronic mail account;

a server mapper for comparing the domain with a list of domains stored in a database;
and

a real time query unit for attempting to access the electronic mail account according to the electronic mail account using the user name and the domain extracted from the address, wherein the server mapper is configured to compare the domain with a list of closed domains that do not include server computers employing the electronic mail protocol.

29. (Original) The device recited in claim 28, wherein the server mapper also compares the domain with a list of known domains, such that at least one server computer known to employ the electronic mail protocol is associated with each of the known domains.

30. (Cancelled)

31. (Previously presented) A device for determining information needed to access an electronic mail account according to an electronic mail protocol, comprising:

an address decomposer for decomposing an address for accessing an electronic mail account into a user name for the electronic mail account and a domain for the electronic mail account;

a server mapper for comparing the domain with a list of domains stored in a database;

a real time query unit for attempting to access the electronic mail account according to the electronic mail account using the user name and the domain extracted from the address; and

a host name generator for concatenating a server name prefix with the electronic mail account domain to form a default name for a server computer.

32-35. (Cancelled)